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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LEROUX, ETIENNE PIERRE	
ART UNIT	**PAPER NUMBER**
2161	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/823,704	ITO ET AL.	
	Examiner	Art Unit	
	Etienne P LeRoux	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 August 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6,9,12,22,24,34-37 and 50-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,9,12,22,24,34-37 and 50-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3212005* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claims Status

Claims 1, 4, 6, 9, 12, 22, 24, 34-47 and 50-55 are pending. Claims 2, 3, 5, 7, 8, 10, 11, 13-21, 23, 25-33, 48 and 49 are canceled. Claims 1, 4, 6, 9, 12, 22, 24, 34-47 and 50-55 are rejected as detailed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6, 9, 12, 22, 24, 34-39, 42, 43, 45 and 52-55 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,535,889 issued to Headrick et al (hereafter Headrick).

Claims 1, 4, 6, 9, 12, 22, 24, 34-39, 42, 43, 45 and 52-55:

Headrick discloses an apparatus for retrieving information from a site on a network, said apparatus comprising:

a display device [Fig 1, 126], an operator unit [Fig 1, 126], a processor device [Fig 1, 100] coupled with a removably attached external storage medium [Fig 1, 122], said display device and said operator unit, said removably attached external storage medium having prestored therein one or more items of first display information each for displaying an emulation screen imitating

a screen of any one of one or more predetermined music-piece-data selling sites accessible via the network, and network address information assigned to the sites for calling up any one of the sites [Fig 1, col 6, lines 53-65, col 8, lines 1-15, col 10, lines 30-35, Fig 3a, 302]

said processor device being adapted to:

read out [Fig 5, par 47] a particular one of the items of the first display information stored in said external storage medium;

cause the emulation screen described by the read-out first display information, to be displayed on said display device; wherein the emulation screen and the screen of the music-piece-data selling site imitated by the emulating screen are similar in design and function [Figs 3a-3e];

manipulate via said operator unit, an access button [Fig 3e, 900] on the emulation screen displayed on said display device, to thereby read out the network address information of a particular selling site corresponding to said emulation screen from said external storage medium and transmit the read-out network address information to the network, in response to the transmitted network address information, receive from said particular sites via the internet, second display information for displaying a screen of the particular site; and switch the emulation screen, displayed on said display device, to the screen of the particular site on the basis of the received second display information [Figs 3a-3e]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 41 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Headrick as applied to claims 1, 4, 6, 9, 12, 22, 24, 34-39, 42, 43, 45 and 52-55 and further in view of US Pat No 6,735,430 issued to Farley et al (hereafter Farley).

Claim 41:

Headrick discloses the elements of claim 40 as noted above but does not disclose wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score. Farley discloses wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score [col 4, lines 14-25]. It would have been obvious to one of ordinary skill in then art at the time the invention was made to modify Headrick to include wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score as taught by Farley for the purpose of providing a means for a

person to play an instrument [col 4, lines 14-25]. The skilled artisan would have been motivated to modify Headrick per the above such that a user can obtain a musical score related to an audio clip such that the user can also play the music which he/she heard on the website.

Claim 46:

Headrick discloses the elements of claim 45 as noted above but does not disclose wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score. Farley discloses wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score [col 4, lines 14-25]. It would have been obvious to one of ordinary skill in then art at the time the invention was made to modify Headrick to include wherein the display information to be transmitted to said client terminal is information for displaying the desired music piece as a musical score as taught by Farley for the purpose of providing a means for a person to play an instrument [col 4, lines 14-25]. The skilled artisan would have been motivated to modify Headrick per the above such that a user can obtain a musical score related to an audio clip such that the user can also play the music which he/she heard on the website.

Claims 40, 44, 47, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Headrick as applied to claims 1, 4, 6, 9, 12, 22, 24, 34-39, 42, 43, 45 and 52-55 and further in view of Pub No US 2002/0062357 issued to Srinivasan.

Claims 40, 44, 50 and 51:

Headrick discloses:

receiving from said client terminal, first request information designating a desired music piece

on the basis of said first request information received from said client terminal, transmitting to said client terminal, display information for displaying the desired music piece in its entirety so that the entire desired music piece can be displayed on said client terminal on the basis of the display information:

receiving from said client terminal, second request information designating at least a desired portion of the displayed music piece, said desired portion being selected by a user of said client terminal from a single piece corresponding to the displayed music piece

on the basis of said second request information received from said client terminal, creating partial music piece data that represent the desired music piece and correspond to the portion designated by said second request information [Figs 1, 3 and 5]

Headrick discloses the essential elements of the claimed invention as noted above but does not disclose determining a selling price of the created partial music piece data. Srinivasan discloses determining a selling price of the created partial music piece data [paragraph 22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Headrick t0o include determining a selling price of the created partial music piece data as taught by Srinivasan for the purpose of enabling a customer to record something for a fee [paragraph 22]. The skilled artisan would have been motivated to modify Headrick per the above such that the owner of a website can conduct ebusiness.

Claim 47:

Headrick discloses the elements of claim 44 as noted above but does not disclose wherein the predetermined billing-related information is at least a credit-card number. Srinivasan the predetermined billing-related information is at least a credit-card number [paragraph 22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Headrick to include the predetermined billing-related information is at least a credit-card number as taught by Srinivasan for the purpose of enabling a customer to record something for a fee [paragraph 22]. The skilled artisan would have been motivated to modify Headrick per the above such that the owner of a website can conduct ebusiness.

Response to Arguments

Applicant's arguments submitted 3/21/2005 have been carefully considered but are now moot based on above new grounds of rejection based on applicant's claim amendments. However, for the sake of completeness of the record, the gist of applicant's arguments are considered below.

Applicant Argues:

Applicant states in the first paragraph connecting pages 22 and 23 "With respect to independent claims 1, 4, 6, 9. 12 and 22, neither Fitzsimmons nor Mankovitz contain any disclosure or suggestion of displaying an emulation screen that imitates a screen of a merchant website, wherein the emulation screen is similar in both design and in function to the actual merchant website. Furthermore, neither on e of the references teach or suggest accessing the actual merchant website simply via an access button on the emulation screen. Rather, Fitzsimmons simply discloses a guide display terminal to be given to a visitor of a facility (e.g., a

museum or art gallery), while Mankovitz discloses an apparatus for ordering supplemental information about programs to be used on a terminal."

Examiner Responds:

Examiner is not persuaded. In response to applicant's argument that Fitzsimmons discloses a guide display terminal while Mankovitz discloses an apparatus for ordering supplemental information, examiner notes above is merely a recitation of the intended use of the prior art. In order for the claimed invention to patentably distinguish over the prior art, the claimed invention must result in a structural difference with respect to structure of the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to the applicant's argument that neither on of the references suggest "accessing the actual merchant website simply via an access button on the emulation screen" applicant is in error regarding the disclosure of Mankovitz. Mankovitz discloses a touch-sensitive screen in paragraph 31, item 364. Mankovitz in paragraph 65 discloses keystrokes made by the visitor during his or her tour of the museum can be collected by the portable device interface, such keystroke and query information can be processed by the user profile database to aid in marketing of products associated with the museum. Figure 7 and paragraphs 68 and 69 disclose the visitors keystrokes and bookmarks are recorded and stored in the portable interface device throughout the duration of the user's visit to the facility. Moreover, a third party museum or third party web site can be tailored to aid further research. Mankovitz in paragraph 64 discloses logging-on to the WWW.

Applicant Argues:

Applicant states in the second paragraph on page 23 "With respect to Claims 34 and new claims 52 and 53, neither Fitzsimmons nor Mankovitz contain any disclosure or suggestion of separately displaying visual representations of a music piece data that distinguishes whether the music piece data may be acquired from a server via a network, or via an external storage medium directory. In fact, neither reference teaches or suggests storing music piece data in an external storage medium.

Examiner Responds:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., separately displaying visual representations of a music piece data that distinguishes whether the music piece data may be acquired from a server via a network, or via an external storage medium directory) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant Argues:

Applicant states in the third paragraph on page 23 "With respect to claims 40, 44, 50 and 51, neither Fitzsimmons nor Mankovitz contain any disclosure or suggestion of, in response to user designating a portion of a music piece, a server determines a selling price of the music portion. Col. 16, lines 48-58 of Mankovitz simply discusses setting selling prices for an album or song; it does not disclose or teach determining a selling price of a portion of a music piece data in response to a user designation of that music piece portion."

Examiner Responds:

Examiner is not persuaded. MPEP § 2106 states that office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Examiner notes that Applicant fails to particularly point to the present specification for a definition of "portion of a music piece." Examiner will thus resort to a common dictionary for a reasonable interpretation of piece of music. The following definition is appropriate "an artistic work or composition as of music, writing, painting, drama.[1] The following excerpt, i.e., paragraph 53, from Fitzsimmons is pertinent:

0053] During the playback of the exhibit introduction audio clip, the portable selection device display screen presents additional information options related to the exhibit. For example, in the context of a music museum, at least two groups of options can be presented to the visitor. A first group, referred to herein as liner notes, is a list of high-level audio clips that provide additional information on the exhibit as a whole (though more detailed than that presented in the exhibit introduction audio clip). **Each selection in the liner note list has an associated number, and the user can enter the number on the portable selection device keypad, or by touching the item on the touch screen. Once a liner note is selected, a liner note audio clip is played back from the internal hard drive, and a corresponding text page is presented on the display screen of the portable selection device.** Advantageously, liner note text pages can include links to related information about the exhibit. For example, a liner note can include an "if you like this, then you should check out . . . " type of statement which points the user to other exhibits in the museum or to upcoming events in the area. As a liner note clip plays back, the visitor can use the transport buttons on the portable selection device to stop, pause, play, fast forward or fast rewind.

The above disclosure by Fitzsimmons clearly reads on above dictionary definition of "portion of piece of music."

Applicant Argues:

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[1] Webster's New World College Dictionary.

Applicant states in the fourth paragraph on page 23 "Finally, Applicants traverse the Examiner's combination of Fitzsimmons and Mankovitz, Fitzsimmons is directed to a system for operating a display facility at a public place such as a museum, while Mankovitz is directed to accessing information related to TV programs. The two references are directed to methods and systems of completely different purposes. The examiner simply does not point to any teachings or suggestions in either Fitzsimmons or Mankovitz that would provide motivation for their combination.

Examiner Responds:

Examiner is not persuaded. Applicant is in error because applicant did not carefully read above references. Fitzsimmons suggests "a piece of music selling site" per the following disclosure included in paragraph 47:

For example, the library workstation 560, (Figure 5), can be made available to facility visitors (e.g., in an area proximate the display galleries) so that they can access the artifacts they selected during their visit and thereby obtain yet more detailed information relating to those artifacts (e.g., from the library server 545). Additionally, visitors can, after leaving the facility, access the selected artifacts via the WWW, as is indicated in FIG. 5 by the WWW site station 570 (it will be appreciated that the WWW station 570 need not be connected directly to the fast network 550, but can be literally any computer connected to the WWW anywhere around the world). :

It would have been obvious t one of ordinary skill in the art at the time the invention was made to modify Fitzsimmons to include details of the "piece of music selling site" as disclosed by Mankovitz who discloses the details of selling a piece of music from a remote site accessible via a network.

Conclusion

Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on 3/21/2005, prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.02(l)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

5/17/2005

MOHAMMAD ALI
PRIMARY EXAMINER